

REMARKS

The Official FINAL Action of March 11, 2003, and the prior art relied upon therein have been carefully studied. Upon entry of the present amendment, the claims in the application will be reduced to only claims 32-37, 41-48 and 52-58. Applicants' claims define novel and unobvious subject matter under §§102 and 103, and such claims should therefore be allowed. Applicants respectfully request favorable reconsideration, entry of the amendments presented above, and allowance.

Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 is noted.

Filed herewith is a Declaration under 37 CFR 1.132 in the name of Dr. Dov Hartal, one of the inventors of the present invention and also one of the inventors of one of the references relied upon. Applicants respectfully request entry and consideration of the attached Declaration of Dr. Hartal. This Declaration was not presented earlier because applicants believed, until receipt of the Final Rejection, that no Declaration was necessary because none of the prior art relied upon shows the use of the "concentrate", as claimed, as a flavor enhancer, and applicants believe that arguments to this effect should be sufficient to overcome the rejections of

record. It was not until after receipt of the Final Rejection that it became apparent that evidence would need to be submitted.

By the amendments presented above, claims 38-40 and 49-51 are proposed to be canceled, with the subject matter of claims 38 and 49 being inserted into main claim 32. In addition, claim 33 is proposed above to be amended to make it depend from claim 32. Accordingly, no new issues are presented by the amendments submitted above, and therefore the amendments presented above should be entered at least for purposes of appeal. Such entry is respectfully requested.

In addition, claim 34 is proposed to be amended above to improve the form of the Markush grouping, and therefore provide claim 34 in a form more appropriate for U.S. practice. In view of the cancellation of claim 38, claims 41 and 42 are proposed to be made to depend from main claim 32; and in view of the proposed cancellation of claim 49, claims 52 and 53 are proposed to be made to depend from claim 33. Claim 55 is proposed to be amended to depend from claim 33. These are all non-narrowing amendments.

Claims 32 and 33 have been rejected under §102 as anticipated by each of Zelkha, Yoji '868 and Yoji '869. These three rejections are respectfully traversed.

First, both claims 32 and 33, prior to the amendments presented above, called for at least two features which are novel over the two Yoji references. These are (1) the provision of a "concentrate", which is not shown by the Yoji references, and (2) the use of such a concentrate as a flavor enhancer which is not shown by any of the three references including Zelkhs. With respect, applicants ask where in any of the three citations these two features is to be found. If the PTO is to persist in these rejections, applicants would respectfully request the PTO to point out **where** these features are to be found in the three citations.

The rejection states that all three citations "teach a clear tomato concentrate added to food". Applicants respectfully disagree. The Yoji citations show the use of a clear tomato liquid, **but not a concentrate**. There is simply no concentrate disclosed in the Yojit citations.

On applicants' second point, the position of the PTO is that flavor enhancement is inherent in the prior art. However, this is legally insufficient. "Absent a showing [by the PTO] of some reasonable certainty of inherency, the rejection... under 35 USC 102 must fail", noting *In re Brink*, 164 USPQ 247, 249. Also please see *Ex parte Cyba*, 155 USPQ 756, 757, (1967) wherein it was stated that for a rejection under §102 based upon inherency to be sustained, "such

inherency must be certain". Also see *In re Oelirch*, 212 USPQ 323, 326, (CCPA 1981) which indicated that inherency must be "inevitable", and is not established by probabilities or possibilities.

The three citations have nothing to do with flavor enhancement, and flavor enhancement is not inherent because it is not "inevitable" or "certain".

As indicated above, the subject matter of claim 38 (also claim 49) is proposed by the amendment presented above relative to claim 32 to be incorporated into all of applicants' claims. As neither claim 38 nor claim 49 has been rejected on the basis of §102, applicants assume that the rejection in any event would be withdrawn upon entry of the amendment presented above to claim 32.

Applicants respectfully request withdrawal of the three rejections based on §102.

Claims 32 and 33 have also been rejected under §103 as obvious from each of the three aforementioned citations. These rejections are also respectfully traversed¹.

The comments made above in applicants' traversal of the rejections based on §102 are applicable also to the

¹ Applicants believe that the rejections under §102 and 103 are inconsistent with one another. A particular claim can be either anticipated by a citation or can be obvious from such citation, but it cannot be both anticipated by and obvious from the same citation.

rejections based on §103, and are therefore respectfully repeated by reference. There is nothing in the Yoji abstracts which would have led the person of ordinary skill in the art to attempt to make a concentrate, or to use such a concentrate for flavor enhancement. What is the PTO relying on to reach the conclusion, respectfully submitted by applicants to be entirely unsupported, that it would have been obvious to use the Yoji clear tomato liquids (again, **not** concentrates) for flavor enhancement? There is not the remotest inference in these abstracts of any such use.

The Zelkha publication discloses the manufacture of dehydrated tomato soluble solids, but gives no specific use thereof. It is only stated at the end of the top paragraph on page 8 that the "soluble tomato solids can further be dehydrated, e.g. into powder form, and used as such". But Dr. Hartal's Declaration establishes as fact that there was no concept of the use of such a material as a flavor enhancer.

As regards the attached Declaration of Dr. Hartal, an expert in the present art, who has personal and direct knowledge regarding both Zelkha and the present invention, applicants respectfully quote from the paragraph spanning pages 1 and 2, and the immediately following paragraph on page 3, of the attached Declaration of Dr. Hartal, on which applicants respectfully rely:

I hereby state as a matter of fact that as of the time of the filing of International application PCT/US94/14264 which later published as WO95/16363, and even thereafter, i.e. at the time of such International publication, my co-inventors and I had no idea of the possible use of clear tomato concentrate (CTC) as a taste enhancer, and there is no indication in such publication of any use of CTC as a taste enhancer.

Further research, subsequent to the publication of WO 95/16363 led to the discovery that CTC could be used as a taste or flavor enhancer, much the same way that other flavor enhancers such as MSG are used, and this was a surprising discovery to us because we had no idea that CTC could be so used and would be effective.

Compelling evidence therefore exists that it was not obvious to those of ordinary skill in the art, or even those who had more than ordinary skill in the art, to use the concentrate, i.e. CTC, as a flavor enhancer. Applicants' claims are therefore directed to a new use of a previously known concentrate, such new use not having been obvious to those skilled in the art at the time the present invention was made.

Applicants respectfully request withdrawal of the rejections based on §103.

Claims 34-58 have been rejected as obvious under §103 from each of the three previously noted citations, further in view of JP '871 and deBarros. These rejections are respectfully traversed.

Applicants' claims have not been treated individually, but have been lumped together. Applicants respectfully submit that this is inappropriate. Each claim deserves to be considered on its own merits. For example, the Final Action states near the end thereof at about the middle of page 4 as follows: "It is also noted that Applicant's broadest claims are not specific for amounts." Why was not claim 58 given consideration? Why were the recitations of the dependent portions of claims 35-37 and 57 not addressed by the PTO in the Final Action? The law is clear that no recitations appearing in a claim are to be ignored or brushed aside.

The rejection states with respect to claim 34 "that the claimed flavor enhancers are notoriously well-known and readily available to one of ordinary skill in the art." Applicants agree, but that has nothing to do with the claimed subject matter. Claim 34 is directed to the use of a combination of a previously known flavor enhancer as recited in the dependent portion of claim 34, along with the clear tomato concentrate as recited in claims 32 and 33. This is a nonobvious combination for the claimed use.

The final Action states at the middle of page 4: "All of the claim limitations and arguments have been considered." Respectfully, applicants do not see that all of the claim recitations have been considered, noting the

discussion of certain dependent claims in the two paragraphs immediately above, as well as some additional claim recitations in subsidiary claims as discussed below.

Thus, claims 43 and 54 require the clear tomato concentrate as used in claims 32 and 33 to be in the form of a powder. Where is such use in powder form shown in the prior art? Where is this made obvious in the prior art?

Claims 44 and 55 require the use as a flavor enhancer of a spray dried CTC. Where is this disclosed or made obvious in the prior art?

Claims 45 and 56 call for a carrier in the method of claims 32 and 33. Where is this shown or made obvious in the prior art?

Claims 47 and 48 require that the clear tomato serum be concentrated to a particular Brix value. Where is this shown or made obvious in the prior art?

The final Action also states that the "prior art clearly teaches the use of a clear tomato concentrate as is claimed." Applicants disagree. **Where** is this shown in the prior art? Applicants pointed out in the preceding Reply what the prior art shows, and the prior art does not show what is claimed. The PTO has not answered or rebutted applicants' prior remarks in this regard, which are respectfully repeated by reference; please see MPEP §§706.07 and 707.07(f), both of

which require that when an applicant makes an argument, the PTO is to answer or rebut it.

The fact of the matter is that the Yoji citations do not disclose any clear tomato concentrate, and the PTO is respectfully challenged to point out where such a concentrate is shown in these abstracts of Yoji. While Zelkha does show such a concentrate, it does not disclose or make obvious its use as a flavor enhancer. All of these facts are now confirmed as facts in the attached Declaration of Dr. Hartal.

Respectfully, the rejections have no basis. Applicants again respectfully request that the rejections based on §103 be withdrawn.

Applicants respectfully request favorable reconsideration, entry of the amendments presented above and entry and consideration of Dr. Hartal's Declaration, and formal allowance.

Respectfully submitted,

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